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EXAMINER
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GIMIE, MAHMOUD

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

1 RECORD OF ORAL HEARING  
2  
3 UNITED STATES PATENT AND TRADEMARK OFFICE  
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6 BEFORE THE BOARD OF PATENT APPEALS  
7 AND INTERFERENCES  
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10 Ex parte MASAO KORIYAMA  
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13 Appeal 2008-0214  
14 Application 10/708,560  
15 Technology Center 3700  
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18 Oral Hearing Held: June 19, 2008  
19  
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22 Before MURRIEL E. CRAWFORD, DAVID B. WALKER, and  
23 JOHN C. KERINS, Administrative Patent Judges  
24

25 ON BEHALF OF THE APPELLANT:  
26  
27

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34 The above-entitled matter came on for hearing on Thursday, June 19, 2008,  
35 commencing at 9:19 am, at the U.S. Patent and Trademark Office, 600  
36 Dulany Street, Alexandria, Virginia, before Deborah Rinaldo, Notary Public.

PROCEEDINGS

JUDGE CRAWFORD: Good morning, Mr. Beutler. You can begin whenever you are ready.

MR. BEUTLER: To be honest with you, this is the first time I've argued a case like this because, quite frankly, the reference does show a structure that corresponds to the claims, at least the broadest claim.

The question is, does it teach the invention that we're claiming? And that is the fact that the water passages between the cylinder block and the cylinder head are arranged in such a way that they go upwardly so that when the block is poured with a molten metal, it will not tend to leave a void.

And that really is the invention in this case, is the way that passages are arranged so that they won't leave a void when the metal is poured into the block in the casting process.

And quite frankly, the reference shows a structure that will achieve that result. It just doesn't teach it. So I'm not sure how to -- like I said, I've never had a case like this before where the reference theoretically would provide the result but it doesn't teach it to one skilled in the art.

JUDGE KERINS: Counsel, with respect to the claim language itself, the examiner, I think the claim language at issue is whether the communication passage has an upper wall that is inclined upwardly.

MR. BEUTLER: Yes.

JUDGE KERINS: And the examiner has pointed to a wall surrounding the pump that begins at element 3A and curves upwardly to element 47 which is -- he calls that the upper wall of the communication passage. Are you saying that that -- are you acknowledging that that does

1 have the upwardly inclining wall relative to the cylinder?

2 MR. BEUTLER: Yes. I have to admit that. I mean, it's obvious that  
3 it does it. But the question is, does it teach the invention? Once you know  
4 why it's done, which is what our case teaches, is to form it that way so there  
5 won't be a void left when the casting is performed.

6 JUDGE KERINS: Is there any evidence that the prior art structure  
7 would not -- would actually end up forming voids when you are casting?

8 MR. BEUTLER: That I can't say but since they appear to be the  
9 same, it probably would result in that. So like I said, I don't know exactly  
10 how to argue this other than we disclosed something, the reason for it, and  
11 the reference doesn't really teach that but it will result in the same end  
12 product.

13 JUDGE KERINS: How about, you did separately argue claims 4 and  
14 5.

15 MR. BEUTLER: The ones on the reinforcing ribs?

16 JUDGE KERINS: Right.

17 MR. BEUTLER: Yeah. And I don't think this reference has those  
18 reinforcing ribs.

19 JUDGE KERINS: With respect to claim 4, the examiner has cited, I  
20 think, generally to a network of ribs 52 in the reference. And with respect to  
21 claim 4, you refer to the ribs as being axially extending.

22 MR. BEUTLER: Yes.

23 JUDGE KERINS: I guess in terms of your drawing figures, are we  
24 talking about when the cylinder block is in its upright position? These  
25 would be running horizontally along an axis?

26 MR. BEUTLER: Yes.

1 JUDGE KERINS: He cites to ribs in Figure 4 that are near elements  
2 W and 3A, and it appears that there is a rib near the top of the cylinder block  
3 as well as something that is largely horizontal extending underneath that.

4 This is in the middle of figure 4. And then a rib below that that's also  
5 horizontal. Is it your position that those are not axially extending ribs?

6 MR. BEUTLER: Basically yes, that's the position, that they are  
7 inclined upwardly to some extent but they don't extend the full length. If  
8 you look at our ribs 59, they really extend the full length of the block or  
9 substantially the full length of the block. And 39 also.

10 JUDGE CRAWFORD: Okay. Thank you.

11 MR. BEUTLER: Like I say, it's a tough case.

12 (Whereupon, the proceedings at 9:25 a.m. were concluded.)